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MARTIN PAGEL

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FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN PAGEL

Appeal 2009-003102
Application 09/469,561
Technology Center 3600

Oral Hearing Held: August 13, 2009

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU
R. MOHANTY, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

WAYNE LININGSTONE, ESQUIRE
Fulbright & Jaworski, LLP
2200 Ross Avenue
Suite 2800
Dallas, TX 75201-2784

The above-entitled matter came on for hearing on Thursday, August 13,
2009, at the U.S. Patent and Trademark Office, 600 Dulany Street,
Alexandria, Virginia, before Victor Lindsay, Freestate Reporting, Inc.

1 PROCEEDINGS
2

3 MR. LIVINGSTONE: My name is Wayne Livingstone and I'm an
4associate involved in the prosecution of this current case on appeal which is
5Application number 09/469,561. With me is Ross Viguet who has
6supervised me in the prosecution of this case. And we both represent
7Stamps.com, the real party of interest for this Appeal. The issues in this
8case have been fully briefed, but I would like to explain to the Board some
9of the distinctions between the art and the claims. So unless the Board has
10any questions or comments at this time, I would like to proceed.

11 JUDGE CRAWFORD: I was wondering if you can explain what
12extracting is?

13 MR. LIVINGSTONE: Okay, extracting is reviewing a data stream
14and taking from that data stream information for later use.

15 JUDGE CRAWFORD: Okay. Is, is that somewhere defined in your
16spec?

17 MR. LIVINGSTONE: It's not completely defined, but the way it's
18used, it's clear that it's taking a subset of, of a data stream for further use.

19 JUDGE CRAWFORD: Okay, go ahead.

20 MR. LIVINGSTONE: Okay. I'd like to first go into the background
21to the whole invention, and it relates to printer data (15) in the method. And
22in completed base postage systems at the time of the invention, it becomes a
23-- to prepare letter from mailing a user or a system operated for the user had
24to first print the letter by sending a data stream to a printer and then
25separately print the stamp on the envelope by sending another postage
26indicia data stream to the printer.

1 In concert with this background, I would like to remind the Board that
2it was -- a long time ago it was -- the application was actually filed in 1999.
3From that background, the current -- this current application is close
4embodiment of the invention where, when printing a letter, a user sends a
5data stream from an application to print that letter, and from that very data
6stream data is extracted, and that extracted data is used to control additional
7functions such as the printing of the postage indicia.

8 Now, in the current rejection, we believe the Examiner's is not taking
9into account the differences between Harman, the cited reference, and the
10claimed invention. And I think the Examiner has also failed to show that
11Harman teaches all the limitations of the claims. For example, consider
12Claim 17 and 41, Claim 17 requires extracting includes examining the data
13stream for pre-established data patterns and wherein said pre-established
14data patterns include the beginning and ending of postage indicia data. So
15Claim -- has a similar limitation. Now, the Examiner asserts that this
16limitation is taught by the data patterns in job streams showing who they're
17to, if you could turn to Harman, Figure 2. In addition, the Examiner asserts
18that Harman's disclosure that unique separators separate job header (12)
19from other data. And that job header (12) -- data relating to postage indicia
20data, but job header (12) actually includes much more than postage indicia
21data. Harman, column 3, line 57 to 65, tells us that job header (12) includes
22data such as the number of document sheets to be accumulated for each mail
23team, whether or not a pre-printed insert has been added to the document
24sheets, the manner in which the accumulated sheets are to be folded, whether
25or not a metered return envelope is to be inserted into the envelope with the
26folded accumulation, and whether or not the mailed piece is to be moistened

1or sealed. Clearly, job header (12) includes data apart from postage indicia
2data. Therefore, the unique separators to which the Examiner refers do not
3separate postage indicia data from other data because the unique separators
4do not -- sorry, the unique separators do not teach the beginning and ending
5of the postage indicia data because what it actually does those separators is
6separate the job header (12) which includes a number of pieces of data
7which I just referenced earlier, it cannot teach the beginning and ending of
8postage indicia data. So, in sum, the Examiner has not shown that extracting
9-- includes examining data patterns including beginning and ending of
10postage indicia data. I think that's a very important distinction between
11Claim 17 and 41 and the cited reference.

12 If, if it's okay, I can proceed to Claims 1 and 33.

13 JUDGE CRAWFORD: Go ahead.

14 MR. LIVINGSTONE: Okay. Claim 1 requires in a method of
15printing a data stream being presented to a printer extracting data bits from
16said data stream where said data stream is provided by an application which
17has not been adapted to control the additional functions. The Examiner
18relies on Microsoft Word which was disclosed in Harman as teaching the
19application that provides the data stream. The Examiner also relies on the
20parts of 112 for carrying all the extraction of the data stream. However, if
21we examine Harman closely, we will see that Microsoft Word actually does
22not provide the data stream that parts of 112 -- instead, as can be clearly seen
23from Figure 3, if you can turn to Figure 3, Microsoft Word provides
24documented, and it's important to know why he provides it, provides --

1 JUDGE CRAWFORD: Well, isn't -- doesn't the Examiner really
2combine word processing application (30) and driver (37) to be the
3application?

4 MR. LIVINGSTONE: Yes, he, he did assert that, that combination.
5That combination, we believe, is antithetical to the explicit claim limitation
6which says that the application is not -- has not been adapted to control the
7additional functions. And if he makes that, that combination, you are
8adapting Microsoft Word to, to control the additional functions. And that's
9one of the disclosures we had in the specification is that you need not
10modify the typical word processing program existing then to do what we are
11claiming.

12 JUDGE CRAWFORD: Well, why, why do you say that the
13combination of 30 and 37 doesn't meet the claim language about not being
14adapted to control additional functions?

15 MR. LIVINGSTONE: Because we -- when, when claim -- driver (37)
16is searching -- well, I mean driver (37) extracts address data. And if you use
17-- and it includes, you know, provides information such as -- postage data,
18all that, and I think in, in other parts you could, you could interpret that as
19potentially controlling additional functions.

20 JUDGE CRAWFORD: Why?

21 MR. LIVINGSTONE: Because the information there that stored (38)
22provides the driver (37) could be used to control additional functions. And,
23you know, we don't believe it would be obvious to do it -- to make that
24combination either because I, I don't think one skilled in the art -- to modify
25a Microsoft Word application.

1 JUDGE CRAWFORD: Well, was he saying to modify or was he just
2saying that we can just consider those two components, 30 and 37, to be the
3application?

4 MR. LIVINGSTONE: But if you do that, it would be adapting to
5control the additional functions.

6 JUDGE CRAWFORD: All right. Can you tell me whether or not
7parser 112 is doing extracting?

8 MR. LIVINGSTONE: My understanding of the Examiner's rejection
9is that the Examiner is interpreting parser 112 to do extracting. That aside,
10let assume it does, our contention is what it is extracting is not what we are
11claiming.

12 JUDGE CRAWFORD: Why?

13 MR. LIVINGSTONE: Because it's extracting a data stream that has
14been -- it's actually a modified job data stream where Microsoft Word
15provides document data. What happens in the Harman process is that the
16document data is integrated with other data by driver 37 and may affect the
17controller (4) resulting in job data and Figure 3 illustrates that. And if the
18data stream from the center controller (4) that parser 112 actually parses and
19that, that is our contention.

20 JUDGE CRAWFORD: Okay.

21 MR. LIVINGSTONE: And our further point is that parser 112
22actually parses that integrated stream into, and this is important, into the
23document data originally provided by Microsoft Word, the angle of data, and
24mail finishing unit control data. And the basis of this is column 7, lines 44
25to 66 in Harman. So -- you know, disclosure in Harman, we believe the

1Examiner has mistakenly relied on a data stream that has not been provided
2by the application, the Microsoft Word application, in, in his rejection.

3 JUDGE CRAWFORD: But I thought that the Examiner is saying that
430 and 37 is the application so the data stream that's provided to controller
5(4) when controller (4) doesn't add the postal rates is the data from the
6application when you consider 30 and 37 to be the application?

7 MR. LIVINGSTONE: We, we are arguing that the Examiner can't
8make that combination, but just assume he does. After that, after the data
9stream leaves that combination, it's also modified by mail sent to controller
10(4).

11 JUDGE CRAWFORD: Well, how is it modified there?

12 MR. LIVINGSTONE: Postal rates and from -- as in 44, if you look at
13Figure 3, that's added at mail center controller (4) in addition to material
14information is also added at mail center controller (4).

15 JUDGE CRAWFORD: Well, I thought that the Examiner is saying
16that in some circumstances Harman discloses that the postal rate can already
17be put in before it even gets to controller 4 so that controller 4 would be a
18pass-through?

19 MR. LIVINGSTONE: Yeah, our reading of that is that it would have
20to be done at driver (37) which is another reason why if the postal rates are
21added there, it's another reason why we're saying driver (37), adding driver
22(37) to word, the word processing application is antithetical to our claim
23language which says not adapted to --

24 JUDGE CRAWFORD: To control --

25 MR. LIVINGSTONE: Sorry --

26 JUDGE CRAWFORD: To control other functions, right?

1 MR. LIVINGSTONE: Correct. So, if you are adding postal rates,
2postal indicia there, if you are, you are -- other functions. So, you know,
3either way, we're running into problems with the claim language. And I
4have not seen an embodiment in Harman that really could be read
5reasonably to meet our claim language because if, if he -- if you assume mail
6center controller (4) does not add postal rates, if you put it at driver (37), you
7are, you are actually adding data that can be used to control the printing of
8additional functions -- controlling additional functions. And, you know,
9we're saying you -- in this, in this claim, you can start off with Microsoft -- I
10mean a word application that's not adapted to --

11 JUDGE FISCHETTI: I have, I have question. You have a restrictive
12limitation there.

13 MR. LIVINGSTONE: What?

14 JUDGE FISCHETTI: You have a restrictive limitation as I see it, the
15non-adapted language. Is there, is there functionality or criticality that is
16attributed to that limitation other than just saying we're not -- that application
17does not have additional purposes?

18 MR. LIVINGSTONE: It is critical in the sense that the limitation
19provides a real benefit to, to the user.

20 JUDGE FISCHETTI: Such as?

21 MR. LIVINGSTONE: Such as you have an application, you buy an
22application, a word processor, off the shelf. You need not modify it to, to do
23what we're claiming. And if you turn to page 5 of our disclosure, the third
24paragraph, it states explicitly one important factor is that the output
25generating software application running in the PC need not be modified. I

1think that is -- at the time of the invention, which was 1999, that, that was a
2critical feature, I think.

3 JUDGE FISCHETTI: One more question. You had the revised cert
4upon claim differentiation if I, if I heard correctly for the, for the term
5extraction. What claim was that where you were seeking that
6differentiation?

7 MR. LIVINGSTONE: Claims 1 and 33, independent claims.

8 JUDGE FISCHETTI: Let me just get to 33.

9 MR. LIVINGSTONE: Once again, the question again?

10 JUDGE FISCHETTI: The -- you seem to be relying on the dependent
11claim to define a term in the independent claim, the term being extraction --
12extracting, rather.

13 MR. LIVINGSTONE: I tried to explain a term in the context of the
14specification because the specification does not explicitly define extraction.
15I think if we read it, the specification applies a whole new mean to extracting
16in light of the specification. I think, you know, I think it would support what
17I said earlier about extraction.

18 JUDGE FISCHETTI: So it looks like you have two, two independent
19claims, one at 33 and you, you're trying to draw the definition from another
20independent claim, namely Claim 33 and, and get that inference of definition
21drawn into 1 is that what your argument was?

22 MR. LIVINGSTONE: I think what I was doing was in explaining, I
23think I may have gone into an example, you know, because as I said, there's
24-- explicit definition in the spec about extraction. So what I was trying to do
25is interpret the word based on its natural, normal meaning and what the
26specification discloses.

1 JUDGE FISCHETTI: Okay.

2 JUDGE CRAWFORD: No more question?

3 JUDGE MOHANTY: Your spec also -- can I go on?

4 JUDGE CRAWFORD: Yes.

5 JUDGE MOHANTY: I have a question. In respect --

6 JUDGE CRAWFORD: Can you hear him?

7 MR. LIVINGSTONE: Barely, I'm sorry.

8 JUDGE MOHANTY: In your specification at page 4, line 23, you say
9extract could also mean the entire document?

10 MR. LIVINGSTONE: Okay, that -- if you read the whole paragraph,
11it says in addition the, the extract could be the entire document. It could be
12sent to some destination. So, in addition to the extracting, that can be read to
13mean in addition to the extracting, you can send a whole document
14elsewhere.

15 JUDGE MOHANTY: Okay.

16 JUDGE CRAWFORD: Any other questions? We don't have any
17further questions. Could you hold on for just one minute?

18 MR. LIVINGSTONE: Sure.

19 JUDGE CRAWFORD: Excuse me, do you have his name and all
20that?

21 COURT REPORTER: Yes, I have that, thank you.

22 JUDGE CRAWFORD: Okay, that's it then.

23 MR. LIVINGSTONE: Okay, thank you very much for your time.

24 JUDGE CRAWFORD: Thank you, all right. Bye-bye.

25 (Whereupon, the hearing concluded on August 13, 2009.)